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Datasheet for the decision
of 3 June 2013

Case Number: T 2427/09 - 3.5.01

Application Number: 96923352.7

Publication Number: 832453

IPC: G06F 17/30, G06F 17/60,
                                G06F 3/06, G06F 13/00

Language of the proceedings: EN

Title of invention:
System for using article of commerce to access remote computer

Patent Proprietor:
Neomedia Technologies, Inc.

Opponents:
Scanbuy, Inc.
Bouygues Telecom
Société Française du Radiotéléphone
FRANCE TELECOM
MTAG

Headword:
Accessing Internet resources/NEOMEDIA

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Admissible generalisation - yes"

Decisions cited:
–

Catchword:
–

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                     It can be changed at any time and without notice.

Case Number: T 2427/09 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 3 June 2013

Appellant: (Patent Proprietor)	Neomedia Technologies, Inc. Suite 600, 2201 Second Street Fort Myers, FL 33901 (US)
Representative:	Lucas, Phillip Brian Lucas & Co. 135 Westhall Road Warlingham, Surrey CR6 9HJ (GB)
Respondent I: (Opponent 1)	Scanbuy, Inc. 54 West 39th Street Fourth Floor New York, NY 10018 (US)
Representative:	Neobard, William John Kilburn & Strode LLP 20 Red Lion Street London WC1R 4PJ (GB)
Respondent II: (Opponent 2)	Bouygues Telecom 20, quai du Point du Jour 92100 Boulogne Billancourt (FR)
Representative:	Regimbeau 20, rue de Chazelles 75847 Paris Cedex 17 (FR)
Respondent III: (Opponent 3)	Société Française du Radiotéléphone Tour Séquoia, 1, Place Carpeaux 92915 Paris la Défense Cedex (FR)
Representative:	Debay, Yves Cabinet Debay 126 Elysée 2 78170 La Celle Saint Cloud (FR)

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Respondent IV: FRANCE TELECOM
(Opponent 4)   6 Place d'Alleray
                             75015 Paris   (FR)

Representative: Rosenberg, Muriel Sylvie
                             Santarelli
                             14 avenue de la Grande Armée
                             B.P. 237
                             75822 Paris Cedex 17   (FR)

Respondent V: MTAG
(Opponent 5)   40 Rue Madeleine Michelis
                             92200 Neuilly—sur—Seine   (FR)

Representative: Rosenberg, Muriel Sylvie
                             Santarelli
                             14 avenue de la Grande Armée
                             B.P. 237
                             75822 Paris Cedex 17   (FR)

Decision under appeal: **Decision of the Opposition Division of the**
                             European Patent Office posted 9 October 2009
                             revoking European patent No. 832453 pursuant to
                             Article 101(3)(b) EPC.

Composition of the Board:

Chairman: S. Wibergh
Members: R. R. K. Zimmermann
                 G. Weiss

Summary of Facts and Submissions

I.   European patent EP 0 832 453 derived from Euro-PCT
        application 96 923 352.7 (publication number
        WO 97/01137 A1) claims protection for a method and a
        computer program product for obtaining access to a
        remote computer. Claims 1, 2, and 9 of the patent read
        as follows (feature enumeration A-E added by the Board):

        "1. A method for obtaining access at a client (28)
        to a resource at a service provider (22) or other
        remote computer (24, 26) on the Internet using a
        tangible article of commerce (48), said method
        comprising:
        A) loading into the client (28) browser software
        programmed to allow interface with machine reading
        means (44) to provide access to a database (60) in
        the service provider (22) or other remote computer
        (24, 26),
        B) wherein the said database (60) has records (62,
        64, 66, 68) each containing an identification
        number (70, 72) and a uniform resource locator
        (74);
        C) machine reading at said client (28), using said
        machine reading means (44), an indicium (46)
        affixed to the tangible article of commerce (48),
        said indicium being the encoded identification
        number (70, 72) corresponding to said article or
        to another tangible article of commerce to
        generate the identification number (70, 72) as a
        character string;
        D) automatically transmitting the character string
        to a web server resident on the service provider
        (22) or other remote computer (24, 26) and

retrieving from the database the uniform resource
locator (74) in the record that matches the
character string;
E) and automatically loading the returned uniform
resource locator (74) into the browser software of
the client (28) and connecting the client to the
resource that has the returned uniform resource
locator (74)."

"2. The method of claim 1, wherein the
identification number is a product identification
number having a first field containing digits for
identifying a manufacturer and a second field (78)
for containing digits identifying a particular
product which is left blank,
and the database is arranged to return a plurality
of uniform resource locators (URLs) of a plurality
of matching records."

"9. A computer program product for obtaining
access at a client (28) to a resource at a service
provider (22) or other remote computer (24, 26) on
the Internet using a tangible article of commerce
(48) by machine reading (84) at the client an
indicium (46) affixed to said tangible article of
commerce, said product having instructions for
performing the method of any of claims 1-8."

II.   In opposition proceedings initiated by opponents O1 to
      O5 the patent was revoked by a decision of the
      opposition division of 9 October 2009 for added subject
      matter (Article 100(c) EPC) in claims 1, 2 and 9 of the
      patent as granted. The reasons were as follows.

First, claim 1 was restricted to the "indirect embodiment" described in connection with figure 5. This embodiment could not be combined with the embodiment using direct coding of network addresses described in connection with figures 8 to 10. The definition in claim 1 of the browser software (cf feature A above) was broader than the original disclosure which additionally required an automatic loading of a "Query Page", interfacing between the browser software and the machine reading means by means of a program (or "process") running on the client, and this program entering the respective encoded identification number read from the articles of commerce into the Query Page displayed by the browser software.

Secondly, not having included ASCII coding in the definition of the "character string" in claim 1 (cf feature C above) was inadmissible. It was the only coding mentioned in the original application and it had to be considered essential since it was not derivable whether it was essential or not.

Thirdly, the feature "automatically transmitting" in claim 1 (cf feature D above) was inadmissible. "Automatically" meant transmitting without user intervention, which was not unambiguously disclosed in the original application. A user having entered an identification number into the Query Page would normally be expected to confirm the input before transmission, and this step was not automatic.

The absence of the feature "extrinsic standard" in the definition of the encoded identification number (cf feature B above), was however found to be admissible

since original claims 12 and 22 defined the
identification number without any limitation regarding
the coding standard.

III.   Dependent claim 2 was found to contravene Article 123(2)
        EPC since, when read in combination with claim 1, it
        defined the automatic loading and connecting of a
        "plurality" of URLs, which was not disclosed in the
        original application. As a consequence, the subject-
        matter of independent claim 9, which referred to
        claim 2, also extended beyond the content of the
        application as filed (cf the decision under appeal,
        point 2.7).

IV.   The patent proprietor (appellant) lodged an appeal
        against the decision on 27 November 2009 and filed a
        statement setting out the grounds of appeal (dated
        5 February 2010) on 9 February 2010. According to the
        appellant, the amendments in claim 1 were clearly
        derivable from the application as filed.

        A browser software programmed to interface with machine
        reading means was disclosed in figures 1 to 7 and on
        page 15 of the original application (cf the PCT
        publication) as an alternative to manual entering of
        data into a Query Page, namely as a program or process
        requesting information from the Internet and supplying
        the UPC number. It followed from original page 11 and
        claims 12 and 22 that the identification number was not
        limited to any specific extrinsic standard.

        The feature "character string" without limitation to
        ASCII was admissible since the ASCII coding was

mentioned in the application only as an example and not as an essential feature of the invention.

Concerning the automatic transmission of the character string, there was no manual operation or transmission mentioned anywhere in the application. Whether the user had to confirm the data transfer or not was not relevant in the context of the automatic transmission.

V.   The submissions of the respondents may be summarised as follows.

Regarding the browser software (cf feature A above), the patent proprietor had not cited a single passage in the application referring to a browser software for interfacing with the machine reading means in the context of indirect URL coding. In particular, the program or process mentioned in line 5 ff. of page 15 did not disclose any such kind of browser or interfacing with the external barcode reader 44. The program replaced a human user by providing the UPC product identification number, but it did not interface with the barcode reader; the browser was merely programmed for processing data transmitted from the barcode reader, but not for implementing an interface with the barcode reader. Contrary to the arguments of the patent proprietor, it would not be admissible to combine the embodiments of using product identification codes for retrieving network addresses and the direct coding and displaying of network addresses on the product as shown in the embodiment of figures 8 to 10.

Regarding the feature "identification number" (cf feature B above) the "extrinsic standard" had an

essential technical effect by excluding existing coding and identification standards.

Regarding the definition of a "character string" (cf feature C above), the respondents emphasised that the original application did not mention any alternative to ASCII coding and that the skilled person would have no reason to generalise this feature.

Regarding the feature "automatically transmitting..." (cf feature D above), the embodiment of figure 1, cited by the patent proprietor as support, was not clearly described in respect to the role and the function of the memory 32 so that an automatic transmission of data starting from the input of the I/O port 38 to the output of the modem 36 and to the service provider 22 could not be unambiguously derived from this embodiment.

Regarding claims 2, 9, and 10 the patent proprietor had not provided any arguments and had apparently abandoned these claims. None of the claims was allowable. First, there was no support in the application as filed for returning and loading a plurality of URLs. Since claims 9 and 10 referred to claim 2, and therefore to an undisclosed embodiment returning and loading more than one URL, these two claims were not allowable either. Furthermore, claim 9 defined a single computer program product whereas it followed from the application that at least two programs, namely one at the server and one at the client side, were necessary to carry out the invention.

VI.   The Board summoned to oral proceedings and invited the
        parties to indicate whether or not they desired the
        discussion at the hearing to be limited to the only
        ground for opposition mentioned in the decision under
        appeal (Article 100(c) EPC). Only respondents III to V
        (opponents 3 to 5) replied. None of them wished the
        Board to decide on further grounds of opposition.

VII.   Respondents III to V alone attended oral proceedings
        before the Board held on 6 February 2013. At the end of
        the hearing, which in accordance with the parties'
        preference was limited to a discussion of the ground of
        opposition under Article 100(c) EPC, the debate was
        closed and it was announced that the decision would be
        given in writing.

VIII.   According to the appellant's request submitted in
        writing the decision under appeal should be set aside
        and the patent should be maintained as granted (main
        request). Furthermore the appellant has stated that
        "(t)he Opposition Division has objected claim (*sic*) 2
        and 9 under article 123(2) EPC, regarding that the
        plurality of URLs conflicts with the automatic loading
        step of claim 1... If the Board of appeal shares this
        opinion, we would point out that then the owner of the
        patent will apply to maintain the European Patent
        without claim 2 and to adapt the application documents
        accordingly ... The same applies to independent
        claim 9."

        Respondents III to V requested that the appeal be
        dismissed.

Respondents I and II have made no submissions as to substance in the appeal procedure.

Reasons for the Decision

1.   The admissible appeal is successful in so far as the decision under appeal is set aside and the case is remitted for further prosecution on the basis of the appellant's alternative request since the ground of opposition under Article 100(c) EPC does not justify the revocation of the patent, and the further grounds of opposition invoked by the respondents have not yet been examined by the opposition division.

The appellant's main request

2.   The appellant's main request is for maintenance of the patent as granted. It thus comprises dependent claim 2 as granted, which the opposition division found to contain added subject matter (cf point III above). The appellant has presented no counterarguments. Considering this objection as not manifestly unfounded, the Board can only dismiss the main request.

The appellant's alternative request

3.   The appellant's alternative request (cf point VIII above) involves the deletion of claim 2 and the deletion of claim 9, but it may not be immediately clear whether the request covers the deletion of claims 2 *and* 9. This, however, becomes evident when the request is read in its proper context. The only reason the opposition division gave for rejecting claim 9 was

that it referred to the method of claim 2 (cf the
decision under appeal, point 2.7). Therefore the
request for maintenance of the patent without claim 9
only makes sense in the case that claim 2 is found to
be inacceptable. Clearly claim 10, which is depending
on claim 9, then also has to be deleted. The
alternative request can therefore only be understood as
directed to the maintenance of the patent on the basis
of claims 1 and 3 to 8 of the patent as granted, claims
2, 9 and 10 having been deleted.

4.   Claim 1 of the alternative request - i.e. claim 1 as
        granted - is the only claim against which objections of
        added subject matter under Article 123 (2) EPC have
        been raised. The Board, however, finds that all
        objections under Article 123(2) EPC concerning the
        claim definitions cited above are unfounded. The
        reasons for this view will now be set out.

5.   According to Article 123(2) EPC a European patent
        application or patent "may not be amended in such a way
        that it contains subject-matter which extends beyond
        the content of the application as filed". A common
        interpretation of this provision is that after an
        amendment the skilled person should not be presented
        with new technical information, i.e. technical
        information that he would not derive directly and
        unambiguously, using common general knowledge, from the
        application as filed. Adding new technical information
        in this sense is a different legal concept than
        extending or broadening the scope of a claim by
        omission of (positive) features. Hence, pointing out
        that an amended claim is "broader" than what the
        original application describes is not sufficient to

prove an infringement of Article 123(2) EPC. Reasons have rather to be given why the omission of a feature adds new technical information to the application. That would be the case if, for example, the application expressly or implicitly conveys the teaching that a feature is a necessary element of the invention. When however a specific feature is described in an exemplary manner for the sole purpose of illustrating a way of carrying out the invention, it may well be possible to omit the feature without infringing Article 123(2) EPC.

6.   In the present case the opponents have objected to the omission of three features in claim 1: the "Query Page" in the definition of the browser software (see feature A); the "extrinsic standard" in the definition of the identification number (see feature B); and the "ASCII coding" in the definition of the character string (see feature C).

7.   Starting with the allegedly missing limitations "Query Page" and "ASCII coding", the Board notes that these features are clearly only details of the "preferred embodiment" described in connection with figures 1 and 7. There is no particular teaching in the application that they are necessary elements of the claimed invention. The mere circumstance that no alternative or variant is found in the application as filed is not an indication of any essential character of those features. In fact, the original disclosure points in the opposite direction. The express objective of the invention is to set up a better way for consumers to access resources on remote computers on the Internet using ordinary products and articles of commerce (cf the section Summary of the Invention at page 5 of the published

application up to line 25). The suggested concept for achieving this objective is clearly set out in the following steps (*loc. cit.*): "The user swipes a bar code reader across the product's UPC symbol. The database then retrieves the URL corresponding to the UPC product data. This location information is then used to access the desired resource on the network."

Undoubtedly, the skilled person would immediately know that there are various technically feasible ways to transmit a character string output from a barcode reader via the Internet to a computer database. According to the preferred embodiment, a user enters the character string encoding the UPC product identification number into a Query Page that is automatically loaded by his browser software onto a local host and then transmitted to a Web server that looks up the entered UPC number in the database. In a variant explicitly disclosed, a program or "process" running on the local host could take the role of the user "in the sense that it is the process which is requesting information from the Internet and supplying the UPC number" (page 15, lines 5 to 9). In view of the concept cited above, the skilled person would immediately understand that ASCII coding and the manner in which the process running on the local host supplies the product identification number to the database server are irrelevant for the solution of the technical problem. Such irrelevant details can be omitted from a claim without adding new technical information to the application.

8.   In this context, there was some dispute about the meaning of the terms "browser software" and "interface

with machine reading means" (cf feature A). The terms of a claim should be interpreted in accordance with their common meaning as generally accepted in the technical field in question and in the light of the description and drawings. Whereas separate embodiments cannot be combined without unambiguous guidance in the application, such a limitation does not normally exist when interpreting the technical terms used in an application. In the present case, the application uses the above terms like "browser" and "interface" in a rather general sense as follows for example from page 2, line 5 ff., or page 17, line 6 ff. Moreover, the term "interface" is normally understood to include both software and hardware implementations and has "symmetric meaning" in the sense that interfacing A with B is interfacing B with A.

For these reasons the Board does not see any inconsistency between the claim definition of the browser software and the preferred embodiment as shown in figures 1 to 7. In addition, the corresponding passage of the claim does not define that the browser software itself interfaces with the machine reading means. This is actually left undetermined: it may be the user or it may be the "process", as described at page 15.

9.   Regarding the feature "extrinsic standard" it has already been observed that the technical implication of this feature is obscure. The explanation given at page 11, line 32 ff ("the assignment of numbers is made a by (*sic*) group or association") defines the origin of the assignment rather than its characteristics. In any case the feature was not present in the original

independent claims 12 and 22, indicating - as already observed by the opposition division - that it is not a necessary element of the invention and thus need not be present in the claim definition.

10.   Turning finally to the feature "automatically transmitting" (cf feature D) - which concerns an addition and not an omission - the Board concurs with the argument of the appellant that the term "automatically" cannot reasonably be held to mean "without any user invention at all". It rather conveys the idea of "more or less automatic" or "not entirely manual". Thus a user-controlled triggering of an otherwise fully automatic data transmission would fall under the scope of the term. Hence, at least the description of the "process" variant of the preferred embodiment (see page 15, lines 5 to 9), discloses the objected feature.

       In summary, claim 1 complies with the requirements of Article 123(2) EPC.

11.   It is useful to point out that if the opposition division had examined all grounds of opposition raised instead of only one of them, the Board could have given a final decision on the case instead of remitting it. Even if the assessment of novelty and inventive step in principle requires a specific claim wording the opposition division could in the present case no doubt have expressed a sufficiently detailed opinion so as to render a referral unnecessary.

Order

For these reasons it is decided that:

The decision under the appeal is set aside and the case is
remitted to the department of first instance for further
prosecution on the basis of claims 1, 3-8 of the patent as
granted.

The Registrar: The Chairman:

T. Buschek   S. Wibergh

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